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EXAMINER

DUCUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/073,040

Applicant(s)

HANAKAWA, YUICHI

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/05)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

## DETAILED ACTION

This Office Action is responsive to Applicant's amendment filed December 2, 2003. The prior rejections are withdrawn due to Applicant's amendments to the claims.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States;

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN

5,336,541 to Kobayashi.

3. Kobayashi provides a sticker comprising a first adhesive region on one end side of a sheet piece formed into a plane shape and a second adhesive region on the other end side of the sheet piece, wherein the second adhesive region is located inwardly of the other end of the sheet piece and in such a position as to maintain a substantially plane-contact state when the sheet piece is attached to an object to which the sheet piece is to be attached or stuck and to maintain ease of peeling from the other end. See Figures 1, 4, and 10 which show at least three pieces of adhesive spaced apart on paper or film, providing the structure and order of instant claims 1 and 3. The

label when peeled off is pasted onto a product or container. See col. 1, ll 25-30, ll 40-68, col. 2, ll 1-63, and col. 3, ll 30-50. See col. 5, ll 20-40 to the coverage width of the gap and adhesive.

4. A distance between the first and second adhesive regions is shorter than a distance from the second adhesive region to the other end of the sticker as instant claim 5 recites, is shown in Figure 1. For example, the third or fourth adhesive over from the left can be the second region and the second adhesive is the first region. The distance widths are thus provided for by Kobayashi.

5. Claims 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,429,850 to Held.

6. Held discovered an ultra-thin adhesive tape and roll. There are two parallel adhesive strips 4 and 3, which are equivalent to applicant's first and second adhesive regions and strips, respectively (see Figure 1). A first area (7) is shown in Figure 1. A second adhesive free area (5) is shown in Figure 1. The width and spacing adjustments when measured in the same direction as applicant recites in instant claims 7 and 11 are shown in Figure 1. Further described by Held at col. 2, ll 44-59, teaching the novelty of having a wider adhesive free area than an adhesive area. Held explains there within: The width of the said adhesive-free region is greater than the width of each one of the tracks. A wide adhesive-free region is the pattern that has been found to give the best results, as regards absence of sudden stresses and violent jolts and of course breakage during winding and unwinding at high speed, when the adhesive tape according to the invention is employed for Mylar film splicing under production conditions, which is surprising as it might be imagined that wider tracks with only a small gap between them would

give a better and stronger splice. The film or backing strip can either be considered equivalent to applicant's sheet material in rectangular form.

7. Claims 7, 9, 12, 13, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,358,587 to Saint et al.

8. Saint provides a sticker comprising a sheet material (20 or 40) having two opposite major surfaces and first (30) and second adhesive (discontinued regions of 50) regions both disposed on one of said major surfaces; the first adhesive region being disposed adjacent an edge of said sheet material, the second adhesive region being spaced from the first adhesive region and an opposite edge of said sheet material by first (space in front of 30) and second (space between 30 and first discontinued region 50) areas of said major surface of said sheet material, respectively, at least said second area being free of adhesive material, wherein a width of said second area, as measured in a direction from the edge adjacent to the first adhesive region to the opposite edge, is larger than a width of said second adhesive region, as measured in said direction. See Figures 2 and 3. See also col. 5, ll 50-65 and col. 6, ll 1-15 teaching the areas free of adhesive and the shapes of the adhesive regions, including parallel lines. To claims 12 and 13, as also shown in Figure 2, a first area (free of adhesive), as measured in said direction is smaller than the width of a second area. See also Figure 3.

9. To instant claim 9, the third adhesive region is the first region of 50, the second region of 50 is the second adhesive region as shown in Figure 2.

10. To instant claim 15, an opposite edge of a sheet material is free of adhesive as denoted by "e" in Figure 3.

*Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,358,587 to Saint et al. in view of USPN 5,050,909 to Mertens et al.

Saint discloses the instant invention as indicated above. Saint is silent to a multiple stack of stickers that can be peeled off a stack of multiple identical stickers. However, that the sticker is able to be "sticker can be peeled off a stack of multiple stickers" is not germane since it has been held that an element that is "being able to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

*In re Hutchinson*, 69 USPQ 138. Further, Mertens teaches a stack of sheet assemblies. The sheets of Mertens have adhesive on them and are arranged in a stacked fashion to be peeled off in the same way as Applicant deems. See col. 1, ll 5-10 and Figures 1, 2, and 4. It would have been obvious to one of ordinary skill in the art to have included a multiple stack arrangement because Mertens provides doing so to remove individual sticker like sheets from a stack.

13. Claim 2, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,336,541 to Kobayashi.

Kobayashi is relied upon above. Kobayashi does not teach an inward distance of 15 mm (instant claim 2) or the length between an end edge and other end of a second and other end is about one-fifth or more of a length of a sheet piece (instant claim 4) or the first and second distance difference of instant claim 6. However, changes in distances and widths are merely optimizable. It would have been obvious to one of ordinary skill in the art to modify the length or distance because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The length and distance effects the coverage area.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,358,587 to Saint et al.

Saint is relied upon above. Saint does not teach a width of 15 mm (instant claim 8) or the a width of a second area is about one-fifth or more of a length of a sheet material (instant claim 10). However, changes in widths are merely optimizable. It would have been obvious to one of ordinary skill in the art to modify the length or distance because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. The width effects the coverage area.

#### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,686,169 to Hassall et. al teaches a pattern to control spread of adhesive during lamination of sheets. USPN 5,599,602 to Leonard et al. teaches double-sided pressure-sensitive adhesive tape and method of making. USPN 5,716,865 to Kumar et al. teaches a silicone-containing copolymer and bleed through resistant substrates.-

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia



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Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 4, 2004

Tamra L. Dicus  
Examiner  
AU 1774

A handwritten signature in dark ink, appearing to read "Cynthia K. Kelly", is written in the lower right quadrant of the page.